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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/753,831 | 01/08/2004 | Bryan V. Hunt | 83789AJLT | 8172 |

7590 06/29/2004

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| EXAMINER | |
|---|---|
| CHEA, THORL | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1752 | |

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/753,831 | HUNT ET AL. |
| | Examiner | Art Unit |
| | Thorl Chea | 1752 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-29 and 34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29 and 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03042004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1, 5, 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0805376A2 (EP'376). See the abstract, page 3, lines 32-33 and pages 148 fist paragraph which disclosed a photothermographic material having organic silver salt, silver halide reducing agent, a hydrazine compound; the photothermographic material having sensitivity at 600 to 850 nm, and a dye that provide an absorbances more preferably at least 0.6 at an exposure wavelength 750 to 1500 nm. The photothermographic material having sensitivity and the absorbance within the preferred range taught in EP'376. The limitation such as "one or more thermally-developable imaging layers having coated and dried while said material is conveyed at rate of at least 5 meters per minute" is directed to the claiming of the material by a process and fails to differentiate the claimed material

and that of that of the prior art of record. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated by or have been found obvious over the teaching of the EP'376. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

4. Claims 3-12, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0805376A2 (EP'376). See organic silver salt including silver salt of an aliphatic carboxylic acid on page 43, lines 39-50; phenol reducing agent on page 51, antifoggant having –C(X1)(X2)(X3) on page 145, last paragraph; the binder in column 147, lines 48-55 including synthetic resin such as polyvinyl acetal; the IR absorbing dye on page 149, lines 30-55, page 150-168; the backing layer and the outermost as protective layer on n page 148, lines 43-56, and antihalation dye A in the backing layer on pages 184, lines 45-54. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use known ingredient taught in EP'376 to provide a material as claimed. The radiation absorbing compounds present in claim 12 is within the scope of the generic compound F4 on page 150 of the EP'376.

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0805376A2 (EP'376) as applied to claims 3-12, 16-18 above, and further in view of Gomez et al (US Patent No. 5,380,635) and EP1083459 A1 (EP'459). The antihalation dyes taught in

Gomez and EP459 have similar functional group to that of the antihalation dyes presented in the claims 13-14. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the dye having similar functional group such as taught in Gomez and EP'459, and thereby provide the claimed invention. See Gomez compound in column 24 and EP'459 on page 6, Formula (1-a) and (1-b). A prima facie case of obviousness may be made when chemical compounds have very close structural similarity and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) (discussed below and in MPEP § 2144) for an extensive review of the case law pertaining to obviousness based on close structural similarity of chemical compounds. See also MPEP § 2144.08, paragraph II.A.4.(c).

6. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0805376A2 (EP'376) as applied to claims 1, 5, 34 above, and further in view of Murray et al (US Patent No. 5,545,515). The processing a step as claimed is taught Murray in column 59-60, claims 32-36. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the process taught in Murray to form an image using the material of EP'376 to provide a process as claimed.

7. Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0805376A2 (EP'376). See the abstract, page 3, lines 32-33 and pages 148 fist paragraph

which disclosed a photothermographic material having organic silver salt, silver halide reducing agent, a hydrazine compound; the photothermographic material having sensitivity at 600 to 850 nm, and a dye that provide an absorbances more preferably at least 0.6 at an exposure wavelength 750 to 1500 nm; organic silver salt including silver salt of an aliphatic carboxylic acid on page 43, lines 39-50; phenol reducing agent on page 51, antifoggant having – C(X1)(X2)(X3) on page 145, last paragraph; the binder in column 147, lines 48-55 including synthetic resin such as polyvinyl acetal; the IR absorbing dye on page 149, lines 30-55, page 150-168; the backing layer and the outermost as protective layer on n page 148, lines 43-56, and antihalation dye A in the backing layer on pages 184, lines 45-54. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to form a material such as suggested in EP'376 to provide the invention as claimed. The limitation such as "one or more thermally-developable imaging layers having coated and dried while said material is conveyed at rate of at least 5 meters per minute" is directed to the claiming of the material by a process and fails to differentiate the claimed material and that of that of the prior art of record. In the absence of showing otherwise, it is asserted that the invention as claimed would have been found obvious over the teaching of the EP'376

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-29 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,689,547 and claims 1-4 of the US Patent No. 6,730,461. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention as claimed and that of the U.S. Patent No. 6,689,547 and US Patent No. 6,730,461 are related to the thermally-developable layers having similar absorbance using similar dyes.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571)272-1328. The examiner can normally be reached on M-F (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on (571)272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea
June 22, 2004

Thorl Chea
Primary Examiner
Art Unit 1752